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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/868,477	06/18/2001	Takeshi Natsuno	9683/88	1827

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 INDIANAPOLIS OFFICE 27879
 BRINKS HOFER GILSON & LIONE
 ONE INDIANA SQUARE, SUITE 1600
 INDIANAPOLIS, IN 46204-2033

EXAMINER

POINVIL, FRANTZY

ART UNIT	PAPER NUMBER
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3692

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/16/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/868,477

Applicant(s)

NATSUNO, TAKESHI

Examiner

Frantzy Poinvil

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 12/27/2006 have been fully considered but they are not persuasive.
2. The Examiner now provides the applicant with an attached PTO-1449 form filed December 22/2003 with all references being initialed as requested.
3. The Examiner's response to the applicant's remarks is incorporated in the rejection found below.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 6, 8 and 15 and 17-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laursen et al (US Patent No. 6,065,120) in view of Hirama (JP 410210073A).

As per claims 1 and 15, Laursen et al disclose a mobile or portable wireless phone having web-browser capability for remotely effectuating a financial transaction

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with a server while being connected to the Internet using CDPD, CDMA GSM or TDMA network infrastructure for facilitating communication therein. See column 5, line 58 to column 6, line 63 of Laursen et al. In the system of Laursen et al, prompts are provided to users of mobile terminals and responses to these prompts are provided to a server of an institution. See column 13, lines 10-67 of Laursen et al.

Laursen et al do not explicitly state the requested communication between the mobile communication terminal and the server of the institution relates to a contract. Hiram discloses a method for requesting services related to a contract from a portable telephone to a remote server. See the abstract.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Hiram into that of Laursen et al in order to enable a financial transaction such as a contract to be mediated using a mobile communication terminal of a user. The motivation would have been to enable electronic commerce on the portable terminal whereby a user may do so at any time or place in their privacy.

2. *Applicant has amended the independent claims to recite that the electronic commerce contract is for a "new electronic-commerce" contract and argued that the combined references deal with pre-existing contract and does not call for a new electronic-commerce contract.*

In response, whether or not the combined references teach a pre-existing contract, the Examiner asserts that pre-existing contract was previously initiated between a customer and a service provider, thus a new electronic commerce contract was inherently present at a past date. Thus, the claims as now amended do not define over the combination of Laursen et al and

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Hirama. Furthermore, it is noted that either Laursen et al and/or Hirama has the capabilities to initiate a new contract or transaction for a product or service. Since the combination of Laursen et al and Hirama discloses transmitting information requested for an electronic commerce entered by a user to a server of an institution which provides a service by contract in accordance with an electronic contract, initiating a new electronic commerce contract would have been obvious to one of ordinary skill in the art to do because both the claimed invention and the combined references do not end only after a new electronic commerce contract is contemplated. Thus, to use or act on a contract, that contract was initiated as a new electronic contract. Furthermore, it is well known in the art that when most contracts are initiated as new electronic contracts, certain customer information must be obtained and stored at a computer or server of the financial service provider. Thus, whether or not the combined references recite these teachings, such would have been obvious to do by one of ordinary skill in the art. Thus, the claims as amended do not distinguish over the art of record.

As per claim 6, Laursen et al disclose a step of conducting user authentication of the user of the mobile communication terminal. See columns 7-8 of Laursen et al.

As per claim 8, the mobile communication terminal of Laursen et al is a mobile telephone.

As per claims 17 and 20, Laursen et al disclose a mobile or portable wireless phone having web-browser capability for remotely effectuating a financial transaction

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with a server while being connected to the Internet using CDPD, CDMA GSM or TDMA network infrastructure for facilitating communication therein. See column 5, line 58 to column 6, line 63 of Laursen et al. In the system of Laursen et al, prompts are provided to users of mobile terminals and responses to these prompts are provided to a server of an institution. See column 13, lines 10-67 of Laursen et al.

In so doing, Laursen et al disclose a server apparatus, which is a relay mode in a communication network comprising functions of:

storing at least a password of a user and subscriber information of a mobile communication terminal served by said mobile communication network, said server apparatus being adapted to relay, on the basis of said subscriber information, communication between said mobile communication terminal and a server terminal of an institution providing a service;

transmitting to a mobile communication terminal accessing said server apparatus, first entry screen data to be displayed on a display of said accessing mobile communication terminal, in response to a service request from said accessing mobile communication terminal said first entry screen data prompting a user of said accessing mobile communication terminal to input a password;

conducting user authentication of said user by matching said password inputted by said user and said password corresponding to said accessing mobile communication terminal stored in memory;

transmitting to said accessing mobile communication terminal second entry data to be displayed on a display of said mobile communication terminal, said second entry

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screen data prompting said user to input information required for said service, in a case that said server apparatus receives, from said user who has been authenticated by said user authentication, a request for a service contract with an institution providing a service.

See columns 12-14 of Laursen et al.

Laursen et al do not explicitly state the requested communication between the mobile communication terminal and the server of the institution relates to a contract. Hiram discloses a method for requesting services related to a contract from a portable telephone to a remote server. See the abstract.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Hiram into that of Laursen et al in order to enable a financial transaction such as a contract to be mediated using a mobile communication terminal of a user. The motivation would have been to enable electronic commerce on the portable terminal whereby a user may do so at any time or place in their privacy.

Laursen et al disclose a step of conducting user authentication of the user of the mobile communication terminal. See columns 7-8 of Laursen et al.

As per claim 18, the combined teachings of Laursen et al and Hiram are discussed above. The combined teaching does not explicitly state the contract being a credit card contract. Laursen et al disclose providing stock information to a user of the mobile communication terminal. Hiram discloses mediating a contract between a user

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and a server. Providing other types information such as a credit card contract using the combination of Laursen et al and Hirama would have been obvious to one of ordinary skill in the art at the time the invention was made because one of ordinary skill in the art viewing the combination of Laursen et al and Hirama would have been motivated to add or substitute any desired kind of contract therein since the combination therein would perform similarly as the type of contract would not affect the functioning of the overall combination. A such, it would have been obvious to one of ordinary skill in the art to also include a credit card contract in the system of Laursen et al and Hirama in order to provide various types of banking services to remote users thus providing an attractive financial system to remote users wherein users can instantly apply and obtain the status of their contract.

As per claims 19 and 21, in the combination of Laursen et al and Hirama, the transmission of data would have been achieved using an encrypted transmission algorithm for security purposes.

3. Claims 2-5, 7, 9-14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Laursen et al (US Patent No. 6,065,120) and Hirama (JP 410210073A) as applied to claims 1 and 16 above in view of Zandi (US Patent No. 5,966,699).

As per claims 2 and 16, the teachings of Laursen et al and Hirama are discussed above. The combined teachings do not explicitly recite the steps of transmitting

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information on approval or denial..., when the contract is approved, transmitting information required for electronic-commerce... and the mobile communication terminal...storing the information in a memory. Laursen et al disclose communicating back and forth between the portable communication terminal and a remote server.

Zandi discloses a system and method for presenting a loan application to a user located in a remote location when in communication with a server. In so doing, Zandi discloses all the claimed transmitting..., when a contract is approved, transmitting information required for electronic-commerce transactions prescribed in the contract...and a remote user computer...storing the information in a memory. Applicant is directed to column 4, line 50 to column 5, line 23 and column 9, lines 19-31 of Zandi.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teachings of Zandi into Laursen et al and Hiram whenever a banking function such as a loan or a contract is being requested by a user of the mobile communication terminal. The motivation would have been to facilitate both lenders and borrowers to effect loan banking functions at any time and from any location and also to confirm terms, conditions and agreement related to their financial transactions.

4. *Applicant's representative then states that Zandi is silent regarding any form of electronic commerce contract.*

In response, the Examiner disagrees with the applicant's assertion because Zandi is directed to a system and method for providing a loan to a potential loan

borrower. As such, the Examiner asserts that a loan includes terms and conditions, and therefore is regarded as an electronic commerce contract.

As per claim 3, data entry and data display are made on the display screen of the portable terminal of Laursen et al.

As per claims 4-5, in the system of Laursen et al, Hirama and Zandi, the entry screen information are stored in the server or in a relaying device of the institution for relaying data exchanges between the mobile communication terminal and the server which provides the service by contract. See figure 1 of Laursen and column 4 of Zandi.

As per claim 7, the combined teaching of Laursen et al and Hirama is not explicitly directed to a contract being a credit card contract. Zandi teaches one type of banking function being a loan method and system. It would have been obvious to one of ordinary skill in the art to also include credit card application in the system of Laursen et al, Hirama and Zandi in order to provide various types of banking services to remote users thus providing an attractive financial system to remote users wherein users can instantly obtain the status of their application.

As per claims 9-12, Laursen et al disclose storing all information at the server of an institution for later transmission to the communication terminal. Laursen et al. Disclose their information relate to the provision of stock information to users of the mobile or cellular phones. These information are stored at a sever of the institution.

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Functions of the information being stored at a server of the financial institution for later communication with a terminal of the system are taught by Zandi. See figures 2-3 and column 4, lines 49-67 of Zandi.

Determining approval or denial of a contract based on information required for contract that have been entered by the user is not explicitly taught by Laursen et al. or Hiram. These functions are taught by Zandi on column 4, line 63 to column 5, line 23 and column 8, line 44 to column 9, line 32 of Zandi.

The motivation to combine Zandi with Laursen et al and Hiram is the same as stated above and furthermore to avoid interfering with sensitive information.

As per claim 13, having the first to sixth steps being conducted without intercepting a call would have been obvious to one of ordinary skill in the art to do in the combined system of Laursen et al, Hiram and Zandi with the motivation of performing a complete transaction with one access to the remote server.

As per claim 14, the combination of Laursen et al, Hiram and Zandi does not explicitly state after conducting the first to third steps, a call is disconnected and wherein call is connected again at a later time so as to conduct the fourth to sixth steps.

Zandi teaches that a user may again access the status of his/her loan. Furthermore, if a call is disconnected, the user being connected again at a later time so as to conduct the fourth to sixth steps would have been obvious to one of ordinary skill

in the art to do when combining Laursen et al, Hirama and Zandi in order to allow the final process of the requested loan.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

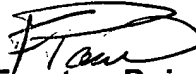
Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frantzy Poinvil whose telephone number is (571) 272-6797. The examiner can normally be reached on Monday-Thursday from 7:00AM to 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on (571) 272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Frantzy Poinvil
Primary Examiner
Art Unit 3692

FP
March 14, 2007